



**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Patent Application

Inventor(s) Carl Edward Werner

Case 2003-0210

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Serial No. 10/767,785

Group Art Unit 2455

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Examiner Michael Young Won

Title Instant Message Mass Update Generated from Website Entry

**COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313-1450**

SIR:

BRIEF ON APPEAL

I. INTRODUCTION

Appellant submits this Brief on Appeal in further support of a Notice of Appeal filed December 16, 2008, the Notice of Appeal having been filed upon receipt of a Final Office Action from the Examiner dated October 7, 2008 affirming the final rejection of pending claims 1, 3-6 and 8-11.

II. REAL PARTY IN INTEREST

AT&T Corp. is the real party in interest by virtue of an Assignment recorded in the United States Patent and Trademark Office on January 29, 2004.

III. RELATED APPEALS AND INTERFERENCES

This is the first appeal in the above-identified application.

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IV. STATUS OF CLAIMS

Claims 1, 3-6 and 8-11 are pending in this application and all stand rejected. The final rejection of these claims is being appealed.

V. STATUS OF AMENDMENTS

No amendments to the claims have been filed subsequent to the receipt of the final rejection.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

The following is a concise explanation of the subject matter as defined in independent claim 1, referring to the specification by page and line number, and the associated drawings. In general, the present invention relates to an arrangement where “an update/alert will be transmitted to all members of an Instant Messaging (IM) group via a live session. If some members of the IM group are not involved in the IM session at the time of the update, an e-mail will be sent as a back-up method of reaching those members” (page 2, lines 17-20; paragraph [0007]).

A further explanation of the subject matter can be found at page 4, beginning at line 10 (paragraph [0016]) – with reference to FIG. 1, where it states:

update/alert administrator 20 receives a particular “update” message that is to be sent to a targeted set of IM groups. Administrator 20 includes means for receiving update/alert messages, manipulating the messages, retrieving “target” IM groups to receive the messages, and sending the alert to the retrieved IM groups In the event a member of an IM group is not participating in the chat session (i.e., either the user is off-line or online, but not engaged in the session) at the time the message is being sent, administrator 20 will retrieve the member’s email address and send the alert/update via email

Concise explanation of independent claim 1

Independent claim 1 defines “an arrangement for transmitting updates/alerts” via “a website update/alert administrator”, the administrator “receiving update or alert messages from said network” and including these elements: (1) a database of IM groups (with a set of ‘members’ for each group); (2) a target listing of various IM groups to

associate sets of IM groups with different types of alerts and updates; (3) a transmission element for sending alert/updates to proper, targeted IM groups, and (4) an email address listing to use for members not engaged in session when alert/update is transmitted.

Concise explanation of independent claim 6

Independent claim 6 is a method claim, defining “a method of transmitting update/alert messages over a data network”, the method including the steps of: (1) receiving an alert/update to be transmitted; (2) retrieving a targeted listing of IM groups to receive the update/alert; (3) transmitting the update/alert to the targeted IM groups; (4) determining if any ‘members’ are not engaged in the session; and (5) sending email update/alerts to those members determined in step (4).

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following is a concise statement of each ground of rejection presented for review:

- Claims 1, 3, 5, 6, 8, 10 and 11 were rejected under 35 USC § 103(a) as being unpatentable over US Publication 2002/198946 (Wang et al.) in view of US Patent 6,301,609 (Aravamudan et al.)
- Claims 4 and 9 were rejected under 35 USC § 103(a) as being unpatentable over US Publication 2002/198946 (Wang et al.) in view of US Patent 6,301,609 (Aravamudan et al.), in further view of US Publication 2002/0065894 (Dalal et al.)

VIII. ARGUMENT

A. 35 USC § 103(a) Rejection - Claims 1, 3, 5, 6, 8, 10 and 11

The Examiner has rejected the above-cited claims under 35 USC 103(a) as being unpatentable over US Patent Publication 2002/0198946 (Wang et al.), in view of US Patent 6,301,609 (Aravamudan et al.). Wang et al. is cited as teaching every aspect of independent claim 1, except for the formation of “groups including a set of members from the plurality of data network system users”. The Aravamudan et al. reference is

used by the Examiner as exemplary of teaching “groups including a set of members from the plurality of data network system users” (with reference to Aravamudan et al. at column 2, lines 33-35, where it states: “The user creates buddy groups and defines specific attributes to associate (buddies) included within each group”).

The Examiner concluded that one would be motivated to combine these references because ‘IM clients also allow the user to specify a list of known identifiers for others of the IM system, often defined as a *buddy list*’ [applicant’s specification at paragraph [0003]]”.

In response, appellant asserts that a significant difference between the combination of cited references and the invention as defined by pending claim 1 is the differences in perspective with respect to how the “groups” are defined. Aravamudan et al. discloses a system where the user is the entity that creates his own group. In this invention, “website update/alert administrator” as defined in claim 1 is the entity which includes “a target listing of various IM groups to associate sets of IM groups with difference types of updates and alerts”. The notion of a target listing of various IM groups is associated in applicant’s invention with the idea that “depending upon the alert/update received by administrator 20, various and different target IM groups may be identified as needing to receive the message” (paragraph [0016]).

In the rejection, the Examiner cited page 2, paragraph [0013] of Wang et al. as teaching the creation of a “target listing” – with a citation to the following text: “A user defines his or her own set of delivery modes, each of which corresponds to a personalized dependability level”. Again, the description from Wang et al. is considered to be a user-driven definition of his preferred ‘delivery mode’ – there is no discussion in this portion of Wang et al. (or elsewhere within the specification) regarding the creation/retrieving of a *targeted listing of various IM groups*, as required in applicant’s independent claims 1 and 6. A significant aspect of the present invention is to provide for timely and efficient transmission of updates/alerts from a system administrator to a *targeted listing* of various IM groups – the targeting allows for only those impacted by the update/alert to receive the message. No such intention is disclosed or suggested in the combination of references cited by the Examiner.

In the Examiner's *Advisory Action* comments, he stated that "although Wang does not teach of IM groups, it would have been obvious to one of ordinary skill in the art to implement groups (as taught by Aravamudan) rather than users in his system".

Appellant cannot agree with the Examiner's characterization of Aravamudan et al., or with the conclusion that this teaching, combined with Wang et al. renders obvious the subject matter of the claimed invention. As described in Aravamudan et al., a system user creates a 'buddy list' of other users – thus forming a 'group' – a grouping initiated at the user level. There is no linkage between this idea of a 'buddy list' and the Wang et al. message transmission; indeed, a proper combination of Wang and Aravamudan would more likely lead to one "user" receiving the message in the Wang system, and the user then taking the responsibility to send the message on to the other users on his 'buddy list' – the administrator of Wang has no access to each user's buddy list.

In light of the above differences, therefore, appellant respectfully requests the Board to review and overturn the Examiner's final rejection.

B. 35 USC § 103(a) Rejection – Claims 4 and 9

Claims 4 and 9 were separately rejected by the Examiner under 35 USC 103(a) as being unpatentable over Wang et al. and Aravamudan et al. (as applied to claims 1 and 6, above), in further view of US Patent Publication 2002/0065894 (Dalal et al.). The Examiner cited Dalal et al. as teaching the inclusion of an IM "trailer portion" indicating that the IM is 'automated' and 'cannot be responded to'. A review of the cited portion of Dalal et al., however, is believed to properly be associated with an autoreply function available to a *receiver* of a message, and not a "trailer" which is a portion of a message *from a transmitter of a message*.

Thus, appellant believes that Dalal et al. does not disclose or suggest this particular aspect of the present invention. Appellant thus requests the Board to review the teaching of Dalal et al. and find the teaching of using a "trailer portion" as defined in

dependent claims 4 and 9 to be allowable – overturning the Examiner’s final rejection of these claims.

IX. CONCLUSION

For the reasons expressed above, the Examiner’s rejection of claims 1, 3-6 and 8-11 under 35 USC § 103(a) is considered to lack merit and thus mandate reversal. Appellant solicits such action from the Board of Appeals at this time.

Respectfully submitted,
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A. CLAIMS APPENDIX

1. *(previously presented)* An arrangement for transmitting updates/alerts over a data network to a plurality of data network system users, the arrangement comprising:

a website update/alert administrator, coupled to the data network, for receiving update or alert messages from said network, said website update/alert administrator including

a database of instant messaging (IM) groups, each group including a set of members from the plurality of data network system users,

a target listing of various IM groups to associate sets of IM groups with different types of updates and alerts,

a transmission element for sending an automated IM to each member of each targeted IM group, the automated IM including the update/alert information; and

a listing of email addresses for each member of each IM group, wherein an email version of an update/alert is sent if a member is not involved in the IM session at the time the automated IM is sent.

2. *cancelled*

3. *(previously presented)* The arrangement of claim 1 wherein the email version of the update/alert requests an acknowledge reply from each IM group member receiving the email version of the update/alert.

4. *(original)* The arrangement of claim 1 wherein the automated IM includes a trailer portion indicating that the IM is “automated” and “cannot be responded to”.

5. *(original)* The arrangement of claim 1 wherein the automated IM includes a request for acknowledge of receipt of each IM group member to confirm that each member of the IM group has received the update/alert.

6. *(previously presented)* A method of transmitting update/alert messages over a data network to a plurality of data network system users, the method comprising the steps of:

a) receiving, at a website administrator, an update/alert message to be sent to a plurality of system users;

- b) using the message information, retrieving a targeted listing of IM groups to whom the update/alert message should be sent;
- c) transmitting the update/alert message as an automated IM to each member of each targeted IM group;
- d) determining if any members of any targeted group are not involved in the IM session at the time the automated IM is sent; and, if so,
- e) retrieving the email address of each user not involved in the IM session; and
- f) transmitting an email version of the automated IM to each user not involved in the IM session.

7. *cancelled*

8. *(previously presented)* The method as defined in claim 6 wherein the transmitted email version includes a request for each user to transmit a confirmation reply message.

9. *(original)* The method as defined in claim 6 wherein the automated IM message transmitted in step c) includes a trailer portion indicating that the message is “automated” and “cannot be responded to”.

10. *(original)* The method as defined in claim 6 wherein the automated IM message transmitted in step c) includes a request to acknowledge receipt of the message by each IM group member by transmitting a confirmation reply message to the website administrator.

11. *(original)* The method as defined in claim 10 wherein the method further comprises the step of:

- g) associating each received acknowledgement with a proper IM group member to determine which IM groups have received the update/alert and which IM group members have not received the update/alert.

B. EVIDENCE APPENDIX

None

C. RELATED PROCEEDINGS APPENDIX

None